

Remarks

Claims 1-22 were previously pending in the subject application. The applicants acknowledge that the subject matter of claims 2, 3, 6, and 13-22 is withdrawn as being directed to non-elected inventions. By this Amendment, the applicants have amended claim 1 and canceled claims 4, 5, and 7-9. Support for the amendments presented herein can be found throughout the original specification including, for example, original claims 5, 7, 8, and 9 and paragraphs 34, 36, and 44. Accordingly, claims 1-3, 6, and 10-22 are now before the Examiner for further consideration.

The applicants wish to thank Examiner Levy for the courtesy extended to the undersigned during the telephonic Examiner Interview conducted today, June 18, 2010. This response and the amendments set forth herein are submitted in accordance with the substance of that interview. Specifically, the applicants have chosen to expedite prosecution of the current case by focusing the claims at this time on the applicants' unique and wholly unexpected compositions, in which the molt-accelerating compounds listed in claims 7 and 8 are combined with the chitin synthesis inhibitors listed in claim 9, with the exception of azadirachtin.

The applicants respectfully submit that the claims as now presented define an invention which was not previously known in the art and, in fact, runs directly counter to all of the relevant teachings at the time of the invention. The applicants also invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Claims 1, 4, 5, and 7 have been rejected under 35 U.S.C. §102(b) as being anticipated by Poppen *et al.* (U.S. Patent No. 6,123,756). The applicants respectfully traverse this rejection because the Poppen *et al.* reference fails to teach or suggest each and every element of the claimed invention.

The rejection of claims 4, 5 and 7 are moot in view of the cancellation of those claims. As indicated in the Office Action, claims 8 and 9 were not anticipated by Poppen. By this amendment, independent claim 1 has been amended to incorporate the limitations of claims 8 and 9. Specifically, claim 1 has been amended to recite compositions comprising a molt-accelerating compound that is an ecdysteroid analog selected from: methoxyfenozide, halofenozide, tebufenozide, RH-5849, and chromafenozide and a chitin synthesis inhibitor selected from hexaflumuron, noviflumuron, diflubenzuron, flufenoxuron, chlorfluazuron, bistrifluron, and lufenuron. The Poppen *et al.* reference only teaches compositions in which at least one juvenile hormone is combined with an ecdysone

agonist. There is no teaching or suggestion of the specific compounds to be combined as disclosed in claim 1, let alone combining an ecdysteroid analog with a chitin synthesis inhibitor.

In order to anticipate, a single prior art reference must disclose within its four corners, each and every element of the claimed invention. In *Lindemann v. American Hoist and Derrick Co.*, 221 USPQ 481 (Fed. Cir. 1984), the court stated:

Anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim. *Connell v. Sears Roebuck and Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983); *SSIH Equip. S.A. v. USITC*, 718 F.2d 365, 216 USPQ 678 (Fed. Cir. 1983). In deciding the issue of anticipation, the [examiner] must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference. *SSIH, supra*; *Kalman v. Kimberly-Clarke*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983)] (emphasis added). 221 USPQ at 485.

In *Dewey v. Almy Chem. Co. v. Mimex Co.*, Judge Learned Hand wrote:

No doctrine of the patent law is better established than that a prior patent . . . to be an anticipation must bear within its four corners adequate directions for the practice [of the subsequent invention] . . . if the earlier disclosure offers no more than a starting point . . . if it does not inform the art without more how to practice the new invention, it has not correspondingly enriched the store of common knowledge, and it is not an anticipation. 124 F.2d 986, 990; 52 USPQ 138 (2nd Cir. 1942).

As noted above, the Poppen *et al.* reference does not disclose the specific ecdysteroid analogs and chitin synthesis inhibitors to be combined in accordance with the claimed compositions. Thus, under the applicable statutory and case law, the Poppen *et al.* reference does not anticipate the current applicants' claims. Therefore, the applicants respectfully request reconsideration and withdrawal of this rejection under 35 USC §102(b).

Claims 1, 4, 5, 9-11 have been rejected under 35 U.S.C. §102(b) as being anticipated by Karr *et al.* (WO 98/344481). The applicants respectfully traverse this rejection because the Karr *et al.* reference fails to teach or suggest each and every element of the claimed invention.

The rejection of claims 4, 5 and 9 are moot in view of the cancellation of those claims. As indicated in the Office Action, claims 7 and 8 were not anticipated by Karr *et al.* By this amendment, independent claim 1 has been amended to incorporate the limitations of claims 7 and 8.

The Karr *et al.* reference teaches compositions in which a juvenile hormone is combined with a chitin synthesis inhibitor. Karr *et al.* do not disclose combining a chitin synthesis inhibitor with an ecdysteroid analog, let alone combining a specific ecdysteroid analog selected from: methoxyfenozide, halofenozide, tebufenozide, RH-5849, and chromafenozide with a chitin synthesis inhibitor selected from hexaflumuron, noviflumuron, diflubenzuron, flufenoxuron, chlorfluazuron, bistrifluron, and lufenuron, as recited in claim 1 as currently amended. Thus, the applicants respectfully submit that the Karr *et al.* reference does not disclose each and every element of the claimed invention. Because Karr *et al.* does not anticipate the claimed invention, withdrawal of this rejection under 35 U.S.C. §102(b) is respectfully requested.

Claims 1, 4, 5, and 7-13 have been rejected under 35 U.S.C. §103(a) as being obvious over Karr *et al.* in view of Poppen *et al.* and Su (U.S. Patent No. 6,857,223). The applicants respectfully traverse this rejection because the cited references, either taken alone or in combination, do not teach or suggest the claimed compositions.

As an initial matter, claims 4, 5, and 7-9 are herein canceled, thus rendering moot the rejection of those claims. The Poppen *et al.* reference describes compositions in which a juvenile hormone is combined with an ecdysone analog. The Poppen *et al.* reference fails to teach or suggest the applicants' claimed composition, that being the combination of an ecdysteroid analog and a chitin synthesis inhibitor. The Karr *et al.* reference also fails to teach or suggest the applicants' current claimed invention. As with Poppen *et al.*, juvenile hormone is one of two main ingredients in Karr *et al.*'s termiticide compositions and there is no teaching or suggestion by Karr *et al.* to combine an ecdysteroid analog with a chitin synthesis inhibitor. Su fails to remedy this defect in the Karr *et al.* and Poppen *et al.* references. Su merely describes impregnating termite bait with a toxicant. There is no disclosure or suggestion by Su to combine toxicants, let alone to combine the specific ecdysteroid analogs and chitin synthesis inhibitors listed in claim 1.

All the claim limitations must be taught or suggested by the prior art in order to establish the *prima facie* obviousness of a claimed invention. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). As discussed above, there is no teaching or suggestion in any of the references of compositions in which particular ecdysteroid analogs are combined with specific chitin synthesis inhibitors as listed in claim 1. Therefore, in the absence of these important features, the cited

references, even combined, would not produce the claimed invention and a *prima facie* case for obviousness of the claimed invention has not been established.

The mere fact that the purported prior art could have been modified or applied in some manner to yield an applicant's invention does not make the modification or application obvious unless "there was an apparent reason to combine the known elements in the fashion claimed" by the applicant. *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1721 (2007). Furthermore, an assertion of obviousness without the required suggestion or expectation of success in the prior art is tantamount to using applicant's disclosure to reconstruct the prior art to arrive at the subject invention. Hindsight reconstruction of the prior art cannot support a §103 rejection, as was specifically recognized by the CCPA in *In re Sponnoble*, 56CCPA 823, 160 USPQ 237, 243 (1969).

In the case of the presently claimed invention, the cited references do not provide any reason for one of ordinary skill to combine an ecdysteroid analog with a chitin synthesis inhibitor as listed in claim 1. Poppen *et al.* teach wood preservatives for protecting wood against dry-wood-destroying insects, such as the house longhorn (*Hylotrupes bajulus*), woodworm (*Anobiunl punctatum*), and bark beetle (*Lyctus brunnens*). Subterranean termites are different from drywood termites, are not dry-wood-destroying insects, and are not mentioned or suggested by the Poppen *et al.* reference. Poppen *et al.* offer no guidance regarding the combination of an ecdysteroid analog with a chitin synthesis inhibitor for use in controlling termites. Thus, it would not have been obvious to the skilled artisan to combine Poppen *et al.*'s wood protectant with Karr *et al.* and Su, both of which are directed to termitecides for use in baits (where the termites are encouraged to consume wood baits having the termitecide). The applicants respectfully assert that any suggestion to combine these references to create and use a composition having both an ecdysteroid analog and a chitin synthesis inhibitor could only be arrived at through hindsight reconstruction which is improper. Accordingly, the applicants respectfully request reconsideration and withdrawal of the obviousness rejection under 35 U.S.C. §103 based on the combination of the Karr *et al.*, Poppen *et al.*, and Su references.

In view of the foregoing remarks and the amendments above, the applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

Respectfully submitted,



Margaret H. Efron
Patent Attorney
Registration No. 47,545
Phone No.: 352-375-8100
Fax No.: 352-372-5800
Address : P.O. Box 142950
Gainesville, FL 32614-2950

MHE/la